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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,798	08/02/2000	Koji Hatanaka	35.G2637	7871
5514 7590 12/11/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TODD, GREGORY G	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/630,798

Applicant(s)

HATANAKA, KOJI

Examiner

Gregory G. Todd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-35, 37, 40-42, 44, 47-49, 51, 53-55, 63 and 65-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-35, 37, 40-42, 44, 47-49, 51, 53-55, 63 and 65-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment and request for continued examination filed 09 October 2007, of application filed, with the above serial number, on 02 August 2000 in which claims 30, 37, 44, 51, and 63 have been amended and claims 36, 38, 39, 43, 45, 46, 50, 52, 56-62, 64, and 68 have been cancelled. Claims 30-35, 37, 40-42, 44, 47-49, 51, 53-55, 63, and 65-67 are therefore pending in the application.

It is noted claim 51 and 63 claim identifiers are listed as 'previously presented' while the claims are actually amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53, 55 recite the limitation "claim 52" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claims will be treated as dependent upon claim 52's previous dependency on claim 51.

Claims 65, 67 recite the limitation "claim 64" in line 1. There is insufficient antecedent basis for this limitation in the claim. The claims will be treated as dependent upon claim 64's previous dependency on claim 63.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-35, 37, 40-42, 44, 47-49, 51, 53-55, 63, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niikawa (hereinafter "Niikawa", 6,668,134) in view of Ward et al (hereinafter "Ward", 6,784,924).

Niikawa teaches the invention, substantially, as claimed including image transferal with image history information (see abstract).

As per Claim 30, Niikawa teaches an image transferring apparatus, comprising:
a storage unit, adapted to store image data (at least col. 3:22-56; eg. memory card);
an image data transfer instruction unit, which is a button for instructing image data transfer, adapted to enable a user to enter an instruction to transfer the image data (at least col. 19:29-36; 'enter' button in user button section of camera to perform retrieval);
a display unit (at least col. 3:45-47; 4:16-31; eg. LCD), adapted to display a first screen to enable a user to select between (1) automatically transferring only image data stored in said storage unit which has not been previously transferred and (2) automatically transferring all image data stored in said storage unit (at least col. 15:36 – 19:40; 13:14 - 14:22; user given many options for image retrieval, including all images and those not yet transferred); and
a transfer control unit, adapted to perform control to automatically transfer the image data (at least col. 1:56-64; automatically transfer information file with transferring the

image data), and (1) to judge a selection selected from the first screen displayed by said display unit, and if the selection to automatically transfer only image data not previously transferred is made, perform control to automatically transfer only the image data not previously transferred based on transfer history information, and if the selection to automatically transfer all image data stored in the storage unit is made, perform control to automatically transfer all the image data stored in said storage unit regardless of the transfer history information (at least col. 15:36 – 19:40; 13:14 - 14:22; user given many options for image retrieval, including all images and those not yet transferred).

Niikawa fails to explicitly teach a second screen to enable a user to select between (1) automatically transferring image data at the time of connection of said image transferring apparatus to another apparatus and (2) automatically transferring image data in response to an instruction to transfer entered by the user with said image data transfer instruction unit, and respective selection judgment. However, the use and advantages for using such image transfer control is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Ward. Ward teaches a user deciding to choose one or more images within LCD menu to transfer and upon connection, automatically establishing a connection according to a utilization file and transmitting the image with 'send' button or LCD send (at least col. 2:1-11; 3:14-49). All the claimed elements were known in Niikawa and Ward. The only difference is Ward provides a more automated transfer process. Thus, one skilled in the art could have combined the elements of Ward to automatically transmit images upon connection with Niikawa's manual image transfer process with no change in their respective

functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention of giving a user an option to automatically transfer images upon being connected to a device or service and transferring new or all images based on history information and user preference.

As per Claim 31. The image transferring apparatus according to claim 30, wherein said display unit comprises a liquid crystal display screen (at least col. 3:45-47; 4:16-31; LCD).

As per Claim 32. The image transferring apparatus according to claim 30, wherein said image data transfer instruction unit is a button provided separately from said display unit (at least Fig. 9(a) ref# 37/772); user button section/ enter).

As per Claim 33. The image transferring apparatus according to claim 30, further comprising a notification unit, adapted to notify, after completion of image data transfer, of the completion (at least col. 19:29-40; eg. results of retrieval).

As per Claim 34. The image transferring apparatus according to claim 30, further comprising a message notification unit, adapted to attach a message notification to the image data to make reference to the transfer history information, and an instruction to delete image data that has not been previously transferred (at least col. 9:19-56; 17:22-40; alerting operator of deletion).

As per Claim 35. The image transferring apparatus according to claim 30, wherein said display unit identifiably displays reduced image data corresponding to the transferred image data based on the transfer history information (at least col. 17:30-60; 10:52-64; reduced resolution images, eg. thumbnails, compressed images).

Claims 37, 40-42, 44, and 47-49 do not add or define any additional limitations over Claims 30-35 and therefore are rejected for similar reasons.

As per Claim 51, Niikawa teaches an image processing apparatus, comprising:

a capturing unit adapted to capture a plurality of bodies of reduced image data, each corresponding to a respective image, from a storage medium of at least one external device (at least col. 17:30-60; 10:52-64; reduced resolution images, ie. thumbnails, compressed images);

a transfer unit, adapted to transfer image data stored in the storage medium (at least col. 13:14-49; transfer of image data);

a display control unit, adapted to perform control so as to display the reduced image data captured by said capturing unit (at least col. 17:30-60; 10:52-64; reduced resolution images displayed, ie. thumbnails, compressed images); and

a screen display control unit (at least col. 3:45-47; 4:16-31; eg. LCD), adapted to perform control so as to display a first screen to enable a user to select between (1) selecting only image data stored in the storage medium which has not been previously transferred and (2) selecting all image data stored in the storage medium (at least col. 15:36 – 19:40; 13:14 - 14:22; user given many options for image retrieval, including all images and those not yet transferred),

wherein said screen display control unit is adapted to control so as to display, selectively, in response to selection made by the user with said screen display control unit, either (1) only any image not previously transferred or (2) all images stored in the

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storage medium (at least col. 15:36 – 19:40; 13:14 - 14:22; user given many options for image retrieval, including all images and those not yet transferred),

wherein said capturing unit captures transfer history information on the image data (at least col. 13:25-58; also 15:36-19:40; upon image files finishing transfer, transferring history data file),

wherein said display control unit changes an order of the reduced image data display based on the transfer history information (at least col. 19:10-40; rank with photographing date).

Niikawa fails to explicitly teach a second screen to enable a user to select between (1) transferring image data at the time of connection of said image transferring apparatus to another apparatus and (2) transferring image data in response to an instruction to transfer entered by the user. However, the use and advantages for using such image transfer control is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Ward. Ward teaches a user deciding to choose one or more images within LCD menu to transfer and upon connection, automatically establishing a connection according to a utilization file and transmitting the image with 'send' button or LCD send (at least col. 2:1-11; 3:14-49). All the claimed elements were known in Niikawa and Ward. The only difference is Ward provides a more automated transfer process. Thus, one skilled in the art could have combined the elements of Ward to automatically transmit images upon connection with Niikawa's manual image transfer process with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the

time of the invention of giving a user an option to automatically transfer images upon being connected to a device or service and transferring new or all images based on history information and user preference.

As per Claim 53. The image processing apparatus according to claim 52, wherein said display control unit performs control so as to display identifiably the reduced image data corresponding to the transferred image data based on the transfer history information (at least col. 17:30-60; 10:52-64; reduced resolution images, eg. thumbnails, compressed images).

As per Claim 54. The image processing apparatus according to claim 51, wherein the screen displayed by said screen display control unit includes a screen which allows a user to select arbitrary image data (at least col. 15:36-19:40; user can select various image information).

As per Claim 55. The image processing apparatus according to claim 52, further comprising a message notification unit, adapted to notify the user by means of a warning message in the event that the transfer history information is referred to, and an instruction to delete the image data not previously transferred is made (at least col. 9:19-56; 17:22-40; alerting operator of deletion).

Claims 63 and 65-67 do not add or define any additional limitations over Claims 51 and 53-55 and therefore are rejected for similar reasons.

Response to Arguments

5. Applicant's arguments filed 09 October 2007 have been fully considered but they are not persuasive. Applicant argues, in substance, that Ward fails to teach a screen enabling a user to select between (1) automatically transferring image data at the time of connection of said image transferring apparatus to another apparatus and (2) automatically transferring image data in response to an instruction to transfer entered by the user with said image data transfer instruction unit, and respective selection judgment. However, Ward teaches a user presented with the decision to choose one or more images within the LCD menu to transfer and upon connection, automatically establishing a connection according to a utilization file and transmitting the image with 'send' button or LCD send (at least col. 2:1-11; 3:14-49). Thus, the user is presented a screen wherein they can select between (2) pushing the 'send' button in the user button section or (1) having the utilization file transmit images accordingly.

Applicant further argues Ward must manually select the images to be transferred and they are not automatically transferred. However, Ward clearly has an automatic system and even uses the term 'automatically', where Ward automatically establishes a connection and transmits the image with activation of the 'send' button or LCD send (at least col. 2:1-11; 3:14-49). Even so, the claims don't exhibit automatic functionality as they present screens to the user upon each transfer for the user to select an option, thus the user has to manually select each 'automatic' transfer. As such, Ward clearly teaches this feature of the claims as amended.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Niikawa et al and Anderson, in addition to previously cited Pavley et al, Morag et al, Miller et al, Otani et al, Dow, Peairs et al, Manolis et al, Anderson et al, Dwyer et al, Dow et al, Shiota et al, Loui et al, Kunishige and Fichtner are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd



Patent Examiner

Technology Center 2100